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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,519	01/04/2001	Noboru Shibuya	275738US6	4153

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EXAMINER

HENNING, MATTHEW T

ART UNIT PAPER NUMBER

2131

DATE MAILED: 05/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/754,519	Applicant(s) SHIBUYA ET AL.	
	Examiner Matthew T. Henning	Art Unit 2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-7 and 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This action is in response to the communication filed on 7/13/2005.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/14/2005 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1-2, 4-7, and 9-11 have been considered but are moot in view of the new ground(s) of rejection.

Claims 1-2, 4-7, and 9-11 have been examined and Claim 3 has been cancelled.

All objections and rejections not set forth below have been withdrawn.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Although there is support for an inactive state where no power is supplied to a cpu, there is no support for the limitation of an inactive state where no power is supplied to a general purpose computer, as recited in claim 4. See the rejection of claims 4-5 below under 35 USC 112 1st Paragraph.

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Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4-5 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Although there is support for an inactive state where no power is supplied to a cpu, there is no support for the limitation of an inactive state where no power is supplied to a general purpose computer, as recited in claim 4. As such, the ordinary person skilled in the art would have been unable to determine that the applicants were in possession of the invention as claimed. Therefore claims 4-5 are rejected for failing to meet the written description requirement of 35 USC 112 1st paragraph.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "said general-purpose computer". There is insufficient antecedent basis for this limitation in the claim.

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Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 6-7, and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Tatebayashi et al. (U.S. Patent Number 6,859,535) hereinafter referred to as Tate.

Regarding claim 1, Tate disclosed a memory card for storing copyrighted music data (See Tate Col. 8 Lines 35-51) comprising: a cross-authentication means for cross-authenticating said memory card with a general purpose computer (See Tate Col. 11 Lines 3-20), said general purpose computer including a controller (See Tate Fig. 5 Element 350) and an internal storage means storing the copyrighted music data (See Tate Fig. 5 Element 370 and Col. 16 Section 1.2.11); a memory card control means (See Tate Fig. 4 Element 270) for receiving said copyrighted music data from said internal storage means of said general purpose computer, and for directly storing the received copyrighted music data into the authenticated memory card (See Tate Col. 11 Line 65 – Col. 12 Line 2) wherein said copyrighted music data stored in said memory card is played on a portable music player device (See Tate col. 8 Lines 44-51)

Regarding claim 9, Tate disclosed a copyright management method for managing storage of copyrighted music data on a memory card (See Tate Col. 8 Lines 35-51), said copyright

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1 management method comprising the steps of: cross authenticating said memory card with a
2 general purpose computer, said general purpose computer including a controller and an internal
3 storage means storing the copyrighted data (See Tate Fig.5 Elements 350 and 370 and Col. 11
4 Lines 3-20 and Col. 16 Section 1.2.11); receiving said copyrighted music data from said internal
5 storage means of said general purpose computer (See Tate Col. 11 Line 65 – Col. 12 Line 2);
6 directly storing the received copyrighted music data into the authenticated memory card (See
7 Tate Col. 11 Line 65 – Col. 12 Line 2), wherein said copyrighted music data stored in said
8 memory card is played on a portable music playing device (See Tate Col. 8 Lines 44-51).

9 Regarding claim 11, Tate disclosed an external memory card (See Tate Fig. 2 Element
10 200) for storing copyrighted music data (See Tate Col. 8 Lines 35-51), the memory card
11 comprising: a memory card driver for cross authenticating said external memory card with a
12 general-purpose computer, said general purpose computer including a controller and an internal
13 memory storing the copyrighted music data (See Tate Fig.5 Elements 350 and 370 and Col. 11
14 Lines 3-20 and Col. 16 Section 1.2.11); and a memory card processor for receiving the
15 copyrighted music data from said internal memory of said general-purpose computer, and
16 directly storing the received copyrighted music data into the authenticated external memory card
17 under the control of said controller (See Tate Col. 11 Line 65 – Col. 12 Line 2), wherein said
18 copyrighted music data stored in said external memory card is played on a portable music
19 playing device, after the copyrighted music data has been transferred from said internal memory
20 of said general-purpose computer into the authenticated external memory card, by connecting
21 said external memory card to said portable music playing device (See Tate Col. 8 Lines 44-51).

Regarding claim 2, Tate disclosed that when said memory card has been cross authenticated with said general purpose computer, said memory card control means plays said copyrighted music data on said portable music playing device by connecting said memory card to said portable music playing device (See Col. 8 Lines 44-51).

Regarding claim 6, Tate disclosed that a function equivalent to said portable music playing device is realized by executing, by said controller of said general purpose computer, a program stored in said internal storage means of said general purpose computer (See Tate Col. 52 Paragraph 1).

Regarding claim 7, Tate disclosed that said internal storage means is a hard disk drive (See Tate Col. 8 Lines 31-34 and Col. 52 Paragraph 1).

Regarding claim 10, Tate disclosed generating a session key to share between the memory card and the general purpose computer once the memory card has been authenticated with the general purpose computer (See Tate Col. 9 Lines 45-60 and Col. 11 Lines 26-31).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tate, and further in view of Doi (U.S. Patent Number 5,432,947).

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1 Tate disclosed that the memory card reads the stored copyrighted data from said memory
2 card and supplies said copyrighted data to said portable music playing device (See Tate Col. 8
3 Lines 44-51), but Tate failed to disclose an inactive state in which no electric power is supplied
4 to said general purpose computer. However, Tate did disclose that the music playing device was
5 separate from the general purpose computer (See Tate Figs. 2-3 and Col. 8 Lines 44-51).

6 Doi teaches that supply voltages to any device can be individually controlled (See Doi
7 Col. 18 Paragraph 9). Doi further shows that the voltage supplied to a device can be cut to 0V,
8 shutting off the power to that device (See Doi Fig. 18).

9 It would have been obvious to the ordinary person skilled in the art at the time of
10 invention to employ the teachings of Doi to the music playing system of Tate in order to shut off
11 the power to the idle personal computer and memory card writer while reading the data from the
12 external medium by the content player. This would have been obvious because the ordinary
13 person skilled in the art would have been motivated to reduce the power consumed by the
14 system.

15 Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Tate
16 and Doi as applied to claim 4 above, as evidenced by Tagawa et al. (US Patent Number
17 6,351,442) hereinafter referred to as Tagawa. Although Tate failed to disclose the content player
18 having a display to display an operation of at least one of the memory card control means and the
19 portable music playing device, it was well known that media players had displays for displaying
20 the operation of the portable music playing device. Therefore, it would have been obvious to the
21 ordinary person skilled in the art to have included one in the music player of Tate. This is further
22 evidenced by Tagawa in Col. 15 Paragraph 4.

Conclusion


Claims 1-2, 4-7, and 9-11 have been rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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5/15/2006


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